REMARKS

This application has been reviewed in light of the Office Action mailed July 13, 2005. Reconsideration of this application in view of the below remarks is respectfully requested. Claims 1-32 are pending in the application with Claims 1, 22 and 23 being in independent form. By the present amendment, Claims 1, 22, and 23 are amended and Claims 24-32, depending from Claims 1, 22 and 23, are newly added. No new subject matter has been introduced by way of the present amendments.

Initially, Applicants thank the Examiner for indicating that Claims 5, 12, 13, 16, 18, 19 and 21 contain allowable subject matter and would be allowable if rewritten to overcome the §112, second paragraph rejection and in independent form including all the limitations of the base claim and any intervening claims.

I. Priority

Regarding the confusion cited by the Examiner involving the claim of priority indicated in Applicants' disclosure, the priority date has expired. Accordingly, please delete paragraph [0001] of the present application, reciting: "This application claims benefits of Japanese Application Nos..." Applicant no longer wishes to claim priority to Japanese Application Nos. 2002-34441, 2002-76777, 2002-91937 and 2002-108209.

II. Rejection of Claims 1-22 Under 35 U.S.C. §101 and 35 U.S.C. §112, Second Paragraph

Claims 1-22 have been rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter and under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the inventive subject matter. Specifically, the Examiner states that the claims

positively recite the human body, which is not a patentable subject matter, thus rendering the claims unclear by the recitation of this non-statutory subject matter. In response, Claims 1 and 22 have been amended in a manner that references the human body in inferential terms rather than positive terms, as suggested by the Examiner. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to Claims 1-22 under 35 U.S.C. § 101 and 35 U.S.C. §112, Second Paragraph.

III. Rejection of Claims 1, 2, 6-8, 10, 14, 15, 22 and 23 Under 35 U.S.C. §102(b)

Claims 1, 2, 6-8, 10, 14, 15, 22 and 23 have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,891,134 issued to Goble et al. (hereinafter, "Goble '134").

Goble '134 teaches an apparatus using an RF generator to provide RF energy between active and return electrodes, which are enveloped by a fluid-filled bladder. The RF energy heats the fluid filling the bladder and in turn heating the bladder wall.

However, Goble '134 does not disclose using an active electrode adapted to supply the body anatomy with high frequency current, as recited in Claims 1 and 22. In addition, Claim 23 has been amended to recite: "...a first high-frequency output step of outputting high-frequency current in a first operation mode from a high-frequency generating device to a body anatomy..." Clearly, Goble '134 does not supply the RF current to the body anatomy but only uses the RF energy to heat the bladder wall, which is in contact with an endometrial tissue layer. (See: Goble '134 col. 4, lines 7-12). Therefore, Goble '134 fails to anticipate all of the subject matter recited in Claims 1 and 22.

Additionally, while Goble '134 attempts to eliminate or at least reduce the vapor pocket formed during operation, the present invention as recited in Applicants' claims,

contrastingly, requires the formation of this vapor pocket in the form of a plurality of bubbles covering the entire periphery of the electrode surface. (SEE: Goble '134, col. 6, lines 6-9; and Applicants' paragraph [0084]). Consequently, Goble '134 teaches away from Applicants' invention with respect to the control and formation of the vapor bubbles.

Therefore, for at least the reasons given above, Claims 1, 2, 6-8, 10, 14, 15, 22 and 23 are believed patentably distinct and allowable over the cited prior art reference. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to Claims 1, 2, 6-8, 10, 14, 15, 22 and 23 under 35 U.S.C. §102(b).

IV. Rejection of Claims 1, 2, 6-8, 10, 14, 15, 22 and 23 Under 35 U.S.C. §102(b)

Claims 1-4, 6-11, 14, 15, 17, 20, 22 and 23 have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,210,405 issued to Goble et al. (hereinafter, "Goble '405").

Goble '405 teaches active and return electrodes disposed in a conductive fluid for the delivery of RF energy to a body anatomy. However, contrary to the Examiner's assertion, Goble '405 fails to explicitly teach controlling the delivery of RF energy based on the presence of bubbles, or impedance generally. All that is mentioned in Goble '405 with respect to controlling the delivery of RF energy is that once the [vaporization] threshold has been reached, the power requirement falls by 30-50%. (See: Goble '405 col. 9, lines 49-54). There is no disclosure regarding how this threshold is detected.

Additionally, as with Goble '134, Goble '405 attempts to eliminate or at least reduce the vapor pocket formed during operation, while the present invention as recited in Applicants' claims, contrastingly, requires the formation of this vapor pocket in the form of a plurality of bubbles covering the entire periphery of the electrode surface.

Therefore, for at least the reasons given above, Claims 1-4, 6-11, 14, 15, 17, 20, 22 and 23 are believed patentably distinct and allowable over the cited prior art reference. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to Claims 1-4, 6-11, 14, 15, 17, 20, 22 and 23 under 35 U.S.C. §102(b).

CONCLUSIONS

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 1-32 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicant's undersigned attorney at the number indicated below.

Respectfully submitted,

Paul J. Esatto, Jr.
Registration No. 30,749

SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City Plaza - Ste. 300
Garden City, New York 11530
(516) 742-4343
PJE:DAT:jam/cm